

REMARKS

Reconsideration of the above-identified application in view of the foregoing amendments and following arguments is respectfully requested.

Claim 12 has been amended. No new matter has been added as a result of this amendment.

Indefinite Rejection Under 35 U.S.C. Section 112, First Paragraph

Claim 12 was rejected under 35 U.S.C. Section 112, second paragraph, as being indefinite for particularly pointing out and distinctly claiming the subject matter regarded as the invention. Specifically, the Examiner stated that claim 12 appeared to contain a grammatical error in the word "claims". Applicant has amended claim 12 to correct the typographical error. Applicant thanks the Examiner for her helpful suggestion.

Written Description – 35 U.S.C. Section 112, First Paragraph

Claims 4, 6-11 and 13-17 are rejected under 35 U.S.C. Section 112, first paragraph as containing subject matter which is not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant respectfully traverses this rejection.

The inquiry into whether the description requirement is met is determined on a case-by-case basis and is a question of fact. Section 2163.04 *Manual of Patent Examining Procedure* (8th Edition, August 2001). When a question regarding the adequacy of the written description arises, the fundamental factual inquiry is whether the specification conveys to those skilled in the art, as of the filing date sought, that Applicant was in possession of the invention being claimed.

Section 2163.02 *Manual of Patent Examining Procedure* (8th Edition, August 2001). Possession can be shown in a number of ways. For example, an Applicant can show possession by: (1) an actual reduction to practice of the claimed invention; (2) a clear depiction of the invention in detailed drawings or in structural chemical formulas which permit a person skilled in the art to clearly recognize that applicant had possession of the claimed invention; or (3) any description of sufficient, relevant, identifying characteristics so long as a person skilled in the art would

recognize that the inventor had possession of the claimed invention. Section 2163 *Manual of Patent Examining Procedure* (8th Edition, August 2001).

A description as filed is presumed to be adequate unless or until sufficient evidence or reasoning to the contrary has been presented by the Examiner to rebut the presumption. Section 2163.04 *Manual of Patent Examining Procedure* (8th Edition, August 2001). The Examiner, therefore, must have a reasonable basis to challenge the adequacy of the written description. *Id.* The Examiner has the initial burden of presenting by a preponderance of the evidence why a person skilled in the art would not recognize in an applicants disclosure a description of the invention as defined by the claims. *Id.*

Applicants respectfully submit that the specification as filed is adequate and reasonably conveys to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Claim 4 of the above-identified application is directed to an interspecific *Lobelia* plant produced by the method of claim 1 having a semi-trailing habit. Claim 5 states that the plant is BFP-100. Claims 6-10 are directed to various parts of the plants of claims 4 or 5. Claim 11 is a product-by-process claim directed to an interspecific *Lobelia* plant having a semi-trailing habit that is produced by (a) crossing a *Lobelia erinus* with a *Lobelia valida*; (b) recovering the resulting F₁ hybrid interspecific *Lobelia* seed; (c) planting the F₁ hybrid interspecific *Lobelia* seed and growing into plants; and (d) selecting an interspecific *Lobelia* plant having a semi-trailing habit. Claims 13-17 are directed to various parts of the plant produced by the method of claim 11.

During the breeding process, ornamental plant breeders make various crosses and selections based on certain ornamental traits of interest, including, but not limited to flower color, flower size, plant habit, etc. Plant breeders are well versed in the types of habits that can be selected for a plant, including, but not limited to, a recumbent habit, semi-trailing habit, trailing habit, etc. Therefore, using the information provided in the specification regarding the method for producing the interspecific *Lobelia* plants of the present invention, one of ordinary skill in the art could readily identify *Lobelia* plants other than BFP-100 having a semi-trailing

habit that are produced as a result of the unique interspecific cross between *Lobelia erinus* and *Lobelia validai*.

In view of the aforementioned arguments, Applicants submit that the Examiner has not met her burden of presenting by a preponderance of the evidence that a person skilled in the art would not recognize in Applicants disclosure, a description of the invention as defined by the claims. Therefore, the rejection of claims 4, 6-11, and 13-17 under 35 U.S.C. Section 112, first paragraph should be withdrawn.

Enablement – 35 U.S.C. Section 112, First Paragraph

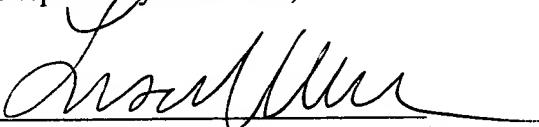
Claims 5-10 and 12 are rejected under 35 U.S.C. Section 112, first paragraph as not being enabled by the specification. In connection with this rejection, Applicant submits that at the appropriate time that regenerable tissues from seed of BFP-100 will be deposited with a recognized depository pursuant to the Budapest Treaty. Applicants wish to hold making such a deposit in abeyance until receipt from the Examiner of notification that claims 4-17 have been allowed.

In view of the aforementioned amendments and arguments, Applicant submits that claims 4-17 are now in condition for allowance.

If any additional fees are incurred as a result of the filing of this paper, authorization is given to charge deposit account number 23-0785.

Respectfully submitted,

By:


Lisa V. Mueller (Reg. No. 38,978)
Attorney for Applicant

WOOD, PHILLIPS, KATZ, CLARK & MORTIMER
500 MADISON STREET
SUITE 3800
CHICAGO, IL 60661
(312) 876-1800

MARKED UP VERSION SHOWING CHANGES MADE:

Claim 12. (Amended). The interspecific *Lobelia* plant of claim[s] 11 wherein said plant is BFP-100.